

REMARKS

Claims 1-33 remain in the application for further prosecution. Claims 32 and 33 have been added.

Allowable Subject Matter

The Examiner has indicated that the subject matter of claims 2 and 12 is allowable. The Applicants appreciate the indication of allowable subject matter in claims 2 and 12. The general subject matter of dependent claim 2 has been added as new independent claim 32. The general subject matter of dependent claim 12 has been added as new independent claim 33, except that some of the “means” language associated with 35 USC § 112, paragraph 6, has been removed.

§§ 102 and 103 Rejections

Claims 1, 3-9, 11 and 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,976,016 (“Moody”).

Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,976,016 (Moody et al.) as applied to claims 1 and 11 above, and further in view of U.S. Patent No. 6,089,976 (“Schneider”).

Claims 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider.

Claims 1 and 11

Claims 1 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Moody. The Applicants have chosen to further clarify the fact that there are **two** distinct outcomes “awarded” to the player based on the player’s selection from the plurality of selectable elements. These amendments should obviate the rejections since Moody fails to disclose these “chain-reaction” features.

Consequently, the Applicants respectfully request the Examiner to reconsider the positions and withdraw the rejections of claims 1, 3-11, and 13-20 under 35 U.S.C. §102 and issuance an allowance of the claims.

Claims 21, 26, and 31

The claim language in claims 21-31 specifically states that there is a “primary game” and a “secondary game.” Both of these terms are well known in the wagering-game prior art and are used in the claims in a manner consistent with the wagering-game art. In fact, the prior art to Schneider that the Examiner relies upon to rejecting claims 21-31 identifies what a primary game is and what a secondary game is, just like the present specification.

The rejection indicates that the claims merely switch the primary game and secondary game, suggesting that Applicants’ position on patentability of the claims is based on “semantics” or “nomenclature.” Applicants disagree with these rejections as set forth previously (and preserve those positions), but have further amended the claims to clarify their position. To illustrate the Applicant’s position that an obviousness rejection **cannot** be made by simply switching Scheider’s primary game and Scheider’s secondary game, the Applicants have rewritten amended claim 26 and switched the words “secondary” and “primary.”

26. (Terms “**Secondary**” and “**Primary**” switched) A method of conducting a wagering game on a gaming machine, the method comprising:

receiving a wager from a player, the wager being associated with a secondary game on the gaming machine, the secondary game allowing access to a primary slot game, the primary slot game only being accessible to the player through the secondary game;

conducting the secondary game free of slot reels and playing cards, the secondary game having a plurality of randomly selected secondary-game outcomes, at least one of the plurality of randomly selected secondary-game outcomes being a start-primary game outcome; and

in response to the start-primary game outcome in the secondary game and without requiring an additional wager from the player, conducting the primary slot game including a plurality of symbol-bearing reels that are rotated and stopped to place symbols on the reels in visual association with a display area.

As can be seen from the “switched” version of amended claim 26, there are several claims elements that are lacking in Schneider, including at least, (i) the wager being associated with a secondary game on the gaming machine, (ii) the primary slot game only being accessible to the player through the secondary game, and (iii) in response to the start-primary game outcome in the secondary game and without requiring an additional wager from the player, conducting the primary slot game. Accordingly, even assuming the Examiner’s switching of Schneider’s “primary game” and Schneider’s “secondary game” is acceptable to reject these claims (which the Applicants believe is not the case), the Examiner is unable to find at least three limitations in Schneider. Thus, a *prima facie* case of obviousness **cannot** be established if at least three claim elements are lacking in Schneider’s teaching.

Furthermore, “[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). See MPEP 2144.04. Thus, in addition to claim elements not being taught by Schneider, the “motivation” element of the *prima facie* case of obviousness seems to be lacking as well.

In short, claims 21-31 are patentable over Schneider.

Conclusion

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number shown.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Daniel J. Burnham", written over a horizontal line.

Date: August 14, 2006

Daniel J. Burnham
Reg. No. 39,618
Jenkins & Gilchrist PC
225 West Washington Street, Suite 2600
Chicago, IL 60606-3418
(312) 425-3900
Attorney for Applicants